

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/851,983

REMARKS

The present invention relates to a top coating composition which comprises a film-forming resin (I) and particular silicate-grafted resin (IV) resulting from graft polymerization of an organosilicate compound (II) onto a hydrolysable silyl-containing resin (III).

In the Office Action of April 1, 2003, it is appreciated that the Examiner withdrew several of the earlier rejections, and in fact has only objected to claims 2-7, indicating such to be allowable if rewritten in appropriate form. However, claim 1 has been rejected under 35 U.S.C. 102(b) based on the abstract of JP 60-199074 A, hereinafter JP '074, which the Examiner has noted discloses a composite resin formed by reacting an alkoxy silyl group-functionalized organic polymer with silica particles.

In response to the Office Action, Applicants have amended claims 1 and 2 herein, and have added new claims 8 and 9 directed to preferred embodiments of the invention. Claim 2 has been amended to place the claim in independent form, thus clearly placing independent claim 2 and dependent claims 5 and 6 in condition for immediate allowance.

Furthermore, Applicants respectfully submit that in view of the amendment of claim 1 herein, all of the claims 1-9 are now in condition for immediate allowance.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/851,983

More particularly claim 1 has been amended to clarify that the silicate compound (II) is an organosilicate compound, and hence claim 1 now more clearly distinguishes over JP '074. In that regard, it is noted that in the background art discussion, at page 1, lines 23-24, reference is made to organosilicates such as methyl silicate or ethyl silicate. More specifically with respect to the present invention, the nature of the compound (II) was more specifically described in detail in the discussion at pages 6-9 of the specification, from which it can be clearly seen that the silicate compound (II) clearly pertains exclusively to organosilicate compounds. This is furthermore evident from the Examples at pages 17-23 of the specification, where it is seen that only organosilicate compounds are utilized. Accordingly, in accordance with the support provided in the disclosure of the specification, claim 1 has been amended herein to more clearly indicate the nature of compound (II) as an organosilicate compound.

Accordingly, it is respectfully submitted that the invention in accordance with amended claim 1 clearly distinguishes over JP '074, which involves silica (SiO_2) particles which have been reacted with alkoxy silyl group-functionalized organic polymer. In contrast to JP '074, the organosilicate compound (II) in the present invention does not involve the use of inorganic silica particles, and hence the present invention clearly distinguishes over JP '074.

With respect to new claims 8 and 9, Applicants note that these claims also do not include silica particles which are disclosed in the prior art. These claims are supported by the disclosure at page 6, as previously amended, and by the disclosure at page 7, lines 18-23 of the specification, and do not raise any new matter issue.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/851,983

Accordingly, it is respectfully submitted that the amendments herein are fully supported, and that all of claims 1-9 are now in condition for immediate allowance.

In view of the above, reconsideration, and allowance of claims 1-9 of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the local Washington telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Lee C. Wright

Lee C. WRIGHT, P.A., PLLC

for Joseph J. Ruch, Jr.
Registration No. 26,577

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: July 31, 2003